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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,894	08/25/2000	Peter L. Katsikas	PKAY-P1	6988

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EXAMINER

HOFFMAN, BRANDON S

ART UNIT	PAPER NUMBER
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2136

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DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,894

Applicant(s)

KATSIKAS, PETER L.

Examiner

Brandon Hoffman

Art Unit

2136

-- Th MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 are pending in this office action.
2. Applicant arguments filed February 10, 2004, have been fully considered but they are not persuasive.

Rejections

3. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. Claim 1-3, 8-13, 16-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Hashimoto et al. (U.S. Patent No. 5,931,905).

Regarding claims 1, 13, and 18, Hashimoto et al. teaches a method/email server system for eliminating unauthorized email sent to a user on a network comprising:

- An email-receiving server connected to the network for receiving a request from an email-sending server on the network to send email addressed to a unique email address of a user subscribing to the email-receiving server (fig. 1, ref. num 30),
 - Said email-receiving server having a senders list module which compares a list of email addresses of senders provided by the user for distinguishing

email sent to the user which are to be accepted from those to be rejected (col. 12, lines 38-41), and

- An email rejection module operable with the senders list module for rejecting the receipt of email addressed to the email address of the user by enabling the email-receiving server to send an error message back to the email-sending server that the email sent under the rejected email address of the sender is not accepted by the email-receiving server (col. 12, line 62 through col. 13, line 4).

Regarding claims 2 and 19, Hashimoto et al. teaches wherein the senders list module is an authorized sender list (ASL) module that includes:

- An ASL database for storing ASL lists of authorized sender addresses for respective subscribers of the system (col. 12, lines 37-41),
- A spam processor module for checking the ASL lists for matches (col. 12, line 67 through col. 13, line 4), and
- An ASL manager for creating, maintaining, and updating the ASL lists (col. 12, lines 43-48).

Regarding claims 3 and 20, Hashimoto et al. teaches wherein the email rejection module includes a redirector module operable with the ASL module:

- For receiving a request to send email message designating the sender's FROM address and intended recipient's TO address (fig. 7, "SENDER" and "DESTINATION"),

- For sending a request for validation to the spam processor module to determine whether the sender's FROM address matches any authorized sender address maintained on the ASL list corresponding to the TO address of the intended recipient (col. 12, lines 62-67),
- For accepting the email if a match to an authorized sender address is found (col. 12, line 67 through col. 13, line 1), and
- For rejecting the email if no match to an authorized sender address is found on the ASL list (col. 13, lines 2-4).

Regarding claim 8, Hashimoto et al. teaches further comprising an email-receiving manager for capturing FROM and TO addresses of email accepted by the redirector-module and sending the data to the ASL manager for later analysis (fig. 17, ref. num 25 of receiving end).

Regarding claim 9, Hashimoto et al. teaches further comprising an email-sending manager for capturing FROM and TO addresses of email sent from the email client and sending the data to the ASL manager for later analysis (fig. 17, ref. num 25 of sending end).

Regarding claims 10 and 16, Hashimoto et al. teaches wherein the senders list module maintaining step includes updating authorized senders lists (ASL lists) using data from an email address source selected from the group of email address sources

consisting of: received email; sent email; user inputs to email service functions on the email client; inputs from user browsing of web sites; user desktop organizer and other contact lists; and third party address program inputs (fig. 57, ref. num 41 and col. 23, lines 24-67).

Regarding claims 11 and 17, Hashimoto et al. teaches wherein the ASL manager further comprises a rules processor for processing predefined analysis rules for updating the ASL lists using data from an analysis source selected from the group of analysis sources consisting of: user email log analysis; expiration date analysis; low/high email volume analysis; fuzzy logic analysis; and third party data analysis.

Applicant states, on page 4, first paragraph, of the preliminary amendment received on August 23, 2001, "all email systems, like the Hashimoto system only scans the FROM and TO addresses of the subscriber's email in order to maintain a log identifying the email the subscribers has sent and received." This admission suggests that the Hashimoto et al. patent, as well as other patents and publications, discloses the ASL manager selects from the group of analysis sources consisting of user email log analysis. This clearly labels the above claims as unpatentable based over a prior art teaching.

Regarding claim 12, Hashimoto et al. teaches wherein the ASL manager maintains the ASL lists designating a sender-address status selected from the group of sender-address statuses consisting of: always authorized as a friend; authorized as a

friend over a date range; authorized as a friend before an expiration date; always rejected as a spammer; rejected as a spammer matching a black list; and rejected as a spammer sent with an error message (col. 13, lines 5-24).

Claim Rejections - 35 USC § 103

5. Claims 4-7, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al. (U.S. Patent No. 5,931,905) in view of Lillibridge et al. (U.S. Patent No. 6,195,698).

Regarding claims 4 and 14, Hashimoto et al. teaches replying to the sender of a rejected email, a message indicating the rejection (col. 13, lines 2-4). However, Hashimoto et al. does not disclose further comprising a web-based messaging (WBM) module to confirm that the sender is a legitimate sender of email to the intended recipient.

Lillibridge et al. teaches further comprising a web-based messaging (WBM) module to confirm that the sender is a legitimate sender of email to the intended recipient (fig. 5).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a WBM module to confirm that a sender is a legitimate sender of email to the intended recipient, as taught by Lillibridge et al., to the

method/system of Hashimoto et al. It would have been obvious to one of ordinary skill in the art to combine a WBM module to confirm that a sender is a legitimate sender of email to the intended recipient, as taught by Lillibridge et al. to the method/system of Hashimoto et al. because most SPAM messages are generated by a machine/agent to distribute to thousands of email addresses. The WBM module will prevent non-human messages from getting to a receivers inbox, thus reducing the hassle of SPAM (see col. 9, lines 3-8 of Lillibridge et al.).

This new method/system, as taught by the combination of Hashimoto et al. and Lillibridge et al. would cause a unregistered email account to be authenticated by the WBM module. This module would force a sender to type in humanly perceptible characters to verify the sender is indeed a human. After correctly typing in the characters, the sender would be allowed to send a message to the intended recipient.

Regarding claims 5 and 15, the combination of Hashimoto et al./Lillibridge et al. teaches wherein the WBM module includes a separate web site (see col. 5, lines 41-43 of Lillibridge et al.) to which the notified sender can log on and confirm that the sender is a legitimate sender of email through an interaction procedure which can only be performed by a human (see col. 6, lines 11-16 of Lillibridge et al.).

Regarding claim 6, the combination of Hashimoto et al./Lillibridge et al. teaches wherein the interaction procedure includes a display of a graphic image of a word in a non-standard font (see fig. 4, ref. num 410 of Lillibridge et al.), and an input for the

sender to enter in a word corresponding to the graphic image of the word (see fig. 4, ref. num 420 of Lillibridge et al.), whereby the system can confirm that the interaction procedure is not performed by a mechanical program (see col. 5, lines 65-67 of Lillibridge et al.).

Regarding claim 7, the combination of Hashimoto et al./Lillibridge et al. teaches wherein once the sender is confirmed as a legitimate sender of email to the intended recipient user, the WBM module sends the email to the user's email box with a code that indicates that the email was rejected by the redirector module but confirmed as legitimate by the WBM module (see col. 6, lines 64-67 of Lillibridge et al., in this case, the request, Q, is to send a message to the recipient.).

Response to Arguments

6. Applicant amends claims 1-3, 13, and 16-20.
7. Applicant argues:
 - a. The Redirector and Authorized Sender List of independent claims 1, 13, and 18 function as part of the email server, thereby rejecting the email message before it is allowed to be received by the email-receiving server; this is opposed to the teaching of Hashimoto et al. that discloses the limitations are performed at the users mailbox (page 3, paragraph 2).

- b. Dependent claims 8-10 and 16 are not taught to include the ASL updating function to add approved sender addresses based on validation from the WBM or from the user manually entering addresses as valid (page 4, paragraph 4).
- c. Dependent claims 11 and 17 are not taught by Hashimoto et al. to include the ASL updating function for analysis of rules to analyze the record of email received/sent to inform the ASL which names to add (page 4, last paragraph to page 5, first paragraph).
- d. Dependent claims 4-7, 14, and 15 are not taught by the combination of Hashimoto et al. in view of Lillibridge et al. based on the argument (argument a above) that the email is not rejected at the server level. Also, Hashimoto does not invite the sender to validate their self via a human-only answerable test (page 5, paragraph 2).

Regarding argument (a); Examiner disagrees with applicant. Figure 1 of the Hashimoto et al. reference shows the AUTHENTICATION DATABASE 35 and the NAME ANALYSIS SERVER PROGRAM 38 contained within the CENTER RESPONSE SERVER 30. The CENTER RESPONSE SERVER 30 in this reference is the email server and the LOCAL RESPONSE SERVER 20 is the email-receiving server. This clearly shows that the rejected emails will indeed be rejected before reaching the email-receiving server. Hence, independent claims 1, 13, and 18 stand as rejected.

Regarding argument (b), Examiner disagrees with applicant. Hashimoto et al., column 12, line 33 through col. 13, line 24, shows that the AUTHENTICATION

DATABASE 35 contains a list of authorized senders as well as rejected senders, which is updated by a user inputting their information in to a screen which is then added to the authorized senders or rejected senders lists. Hence, dependent claims 8-10 & 16 stand as rejected.

Regarding argument (c), Examiner disagrees with applicant. This argument is invalid because the dependency of claims 11 and 17 depend from claims 1 & 2 and 13, respectively. Therefore, this argument never relies on claims 8-10 & 16 and the "supposed name analysis" is not part of claims 11 and 17. Hence, claims 11 and 17 stand as rejected.

Regarding argument (d), Examiner disagrees with applicant. Based on the Examiners response to argument (a), claims 4-7, 14, and 15 stand as rejected. Hashimoto in view of Lillibridge rejected claims 4-7, 14, and 15. Therefore, the argument that Hashimoto (ONLY) did not teach using a human-only answerable test is invalid because the combination of Hashimoto in view of Lillibridge taught the limitation.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 703-305-4662. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



BH
3/5/04



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